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OCT 24 2008

**OFFICE OF PETITIONS**

In re Application of :  
Thomas et al. :  
Application No. 10/748,720 : DECISION ON APPLICATION  
Filed: December 30, 2003 : FOR  
Atty Docket No. UTSD:703USC1 : PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)," filed April 29, 2008. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to one hundred nineteen (119) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is sixty-five (65) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On April 3, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days. On April 29, 2008, applicants timely submitted an application for patent term adjustment (with required fee)<sup>1</sup>. Applicants dispute the period of reduction of

<sup>1</sup> PALM records indicate that the Issue Fee payment was received on June 25, 2008.

231 days entered for applicant delay in responding to the Office action mailed September 23, 2005. Applicants point to the fact that by decision mailed October 10, 2006, the Office determined that a reply was timely submitted on December 27, 2005.

Applicants conclude that in view thereof a period of reduction of 4 days, not 231 days, should have been entered.

The record supports a conclusion that any patent granted on this application is subject to a terminal disclaimer.

A review of the application history reveals that no response to the Office action mailed September 23, 2005 was considered timely filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed May 22, 2006. In response, on August 11, 2006, applicants filed a petition to withdraw the holding of abandonment.

Preliminarily, it is noted that the petition to withdraw the holding of abandonment was filed more than two months from the mailing date of a notice of abandonment. Thus, a period of reduction should have been entered for applicant delay within the meaning of 37 CFR 1.704(c)(4). A period of reduction of 20 days is being entered (July 23 - August 11, 2006).

By decision mailed October 10, 2006, the petition was granted on the basis that applicants had shown that they timely responded to the Office action on December 27, 2005. The filing of a response on December 27, 2005 to the Office action mailed September 23, 2005 was outside the three-month period set forth in 37 CFR 1.704(b). In view thereof, it is concluded that applicants did fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action. The period of reduction, as agreed by applicants for this delay, is 4 days.

Further, on petition, it was established that the response filed December 27, 2005 (and lost by the Office) included an amendment and a notice of appeal. The resubmission of a copy of the notice of appeal on petition filed August 11, 2006 was not applicant delay. Entry of a period of reduction of 231 days was this filing was not warranted.

In view thereof, the period of reduction of 231 days is being removed and a period of reduction of 4 days is being entered.

A review of the application record further reveals that an additional period of reduction of 34 days should have been entered for applicant delay. The reply filed May 25, 2005 was incomplete. As stated in MPEP 2732:

37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Submitting a reply having an omission requires the Office to issue an action under 37 CFR 1.135(c) and await and process the applicant's reply to the action under 37 CFR 1.135(c) before the initial reply (as corrected) can be treated on its merits. In addition, 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In this instance, applicants filed a response to the non-final Office action on May 25, 2005. However, the response did not include the required terminal disclaimer. On June 28, 2005, applicants filed the terminal disclaimer. Pursuant to 37 CFR 1.704(c)(7), a period of reduction of 34 days is being entered for the period beginning on the day after the date the reply having an omission was filed, May 26, 2005, and ending on the date that the reply or other paper correcting the omission was filed, June 28, 2005.

The 125 days entered for Office delay and 2 days entered for applicant delay are not in dispute.


In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is sixty-five (65) days (125 days of Office delay - 60 (20 + 4 + 34 + 2) days of applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management so that a patent can be issued. The patent term adjustment indicated on the patent (as shown on the Issue

Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of Revised PALM Screen

Day : Friday  
Date: 10/17/2008

# PALM INTRANET

Time: 13:21:04

## PTA Calculations for Application: 10/748720

Application Filing Date:	12/30/2003	PTO Delay (PTO):	125
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	233
Post-Issue Petitions:	0	Total PTA (days):	65
PTO Delay Adjustment:	173		

## File Contents History

Number	Date	Contents Description	PTO	APPL	START
97	10/17/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		34	
96	10/17/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		4	
95	10/17/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		20	
94	10/17/2008	ADJUSTMENT OF PTA CALCULATION BY PTO	231		
84	04/03/2008	MAIL NOTICE OF ALLOWANCE			
83	03/31/2008	ISSUE REVISION COMPLETED			
82	03/31/2008	DOCUMENT VERIFICATION			
81	03/31/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
80	03/31/2008	EXAMINER'S AMENDMENT COMMUNICATION			
79	03/31/2008	NOTICE OF ALLOWABILITY			
74	01/23/2008	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
73	01/18/2008	DATE FORWARDED TO EXAMINER			
72	01/09/2008	RESPONSE AFTER EX PARTE QUAYLE ACTION			
71	12/13/2007	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)	125		64
70	12/10/2007	EX PARTE QUAYLE ACTION			
69	12/11/2007	MAIL NOTICE OF RESCINDED ABANDONMENT			
66	09/19/2007	APPEAL BRIEF REVIEW COMPLETE			
65	09/19/2007	DATE FORWARDED TO EXAMINER			
64	04/10/2007	APPEAL BRIEF FILED			
63	04/10/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
62	08/28/2007	CASE DOCKETED TO EXAMINER IN GAU			
59	07/12/2007	DATE FORWARDED TO EXAMINER			
58	08/11/2006	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			

57	08/11/2006	NOTICE OF APPEAL FILED		231	44
56	07/12/2007	NOTICE OF RESCINDED ABANDONMENT IN TCS			
55	07/11/2007	CASE DOCKETED TO EXAMINER IN GAU			
54	04/23/2007	CORRESPONDENCE ADDRESS CHANGE			
53	04/23/2007	CORRESPONDENCE ADDRESS CHANGE			
51	10/10/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
50	08/11/2006	PETITION ENTERED			
49	05/22/2006	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
48	05/15/2006	ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
44	09/23/2005	MAIL NON-FINAL REJECTION			
43	09/19/2005	NON-FINAL REJECTION			
42	07/15/2005	PARALEGAL TD ACCEPTED			
41	06/28/2005	TERMINAL DISCLAIMER FILED			
40	07/12/2005	DATE FORWARDED TO EXAMINER			
39	06/28/2005	FEE PAYMENT RECORDED (FEES FILED SEPARATELY E.G. NOT WITH ORIGINAL PAPERS, ETC).			
38	06/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
37.7	05/25/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	35
37	05/25/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	06/08/2005	DATE FORWARDED TO EXAMINER			
35	05/25/2005	RESPONSE AFTER NON-FINAL ACTION		2	33
34	06/02/2005	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
33	02/23/2005	MAIL NON-FINAL REJECTION			
32	02/22/2005	NON-FINAL REJECTION			
31	11/22/2004	PRELIMINARY AMENDMENT			
30	11/22/2004	WORKFLOW INCOMING AMENDMENT IFW			
29	10/25/2004	CASE DOCKETED TO EXAMINER IN GAU			
28	03/18/2004	REFERENCE CAPTURE ON IDS			
27	09/28/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
26.7	03/18/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

26	03/18/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
25	12/30/2003	PRELIMINARY AMENDMENT			
24	09/28/2004	CASE DOCKETED TO EXAMINER IN GAU			
23	09/02/2004	APPLICATION RETURN FROM OIPE			
22	09/02/2004	APPLICATION RETURN TO OIPE			
21	09/02/2004	APPLICATION RETURN FROM OIPE			
20	09/02/2004	APPLICATION IS NOW COMPLETE			
19	09/02/2004	APPLICATION RETURN TO OIPE			
18	09/02/2004	APPLICATION RETURN FROM OIPE			
17	09/02/2004	APPLICATION IS NOW COMPLETE			
16	07/29/2004	ADDITIONAL APPLICATION FILING FEES			
15	07/29/2004	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
14	08/05/2004	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
13	05/25/2004	SEQUENCE ERRORS			
11	05/20/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
10	05/19/2004	APPLICATION RETURN TO OIPE			
9	05/19/2004	APPLICATION RETURN FROM OIPE			
8	05/19/2004	APPLICATION RETURN TO OIPE			
7	05/19/2004	APPLICATION DISPATCHED FROM OIPE			
6	05/20/2004	APPLICATION IS NOW COMPLETE			
5	03/09/2004	CLEARED BY L&R (LARS)			
4	02/26/2004	REFERRED TO LEVEL 2 (LARS) BY OIPE CSR			
3	02/26/2004	CASE CLASSIFIED BY OIPE			
2	01/17/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/30/2003	INITIAL EXAM TEAM NN			

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#### EXPLANATION OF PTA CALCULATION

#### EXPLANATION OF PTE CALCULATION

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